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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,150	08/30/2000	Donald Payan	A-65679-I/RMS/DHR	2755
24353	7590	11/18/2003	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025			SEHARASEYON, JEGATHEESAN	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/651,150	PAYAN, DONALD
	Examiner Jegatheesan Seharaseyon	Art Unit 1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 July 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 9-18 and 26-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 9-18 and 26-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. This office action is in response to the amendment and remarks filed on 7/17/2003. Claims 9-18 and 26-29 are pending.
2. Applicant has provided in the specification references to the prior applications to claim priority.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.
4. Any objection or rejection of record, which is not expressly repeated in this action, has been overcome by Applicant's response and withdrawn.
5. Applicant's arguments filed 17 July 2003 have been fully considered and are deemed to be persuasive with respect to the rejections of record.
6. Applicant has also provided a terminal disclaimer to over come the rejections of claims 9-15 and 26-29. Claims 9-15 and 26-29 were rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims of U.S 6,555,314.
7. New grounds of rejections.

### ***Claim Rejections - 35 USC § 112***

8. Claims 9-18 and 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 8a. Claim 9 is rejected as vague and indefinite for reciting the term "Toso" because the full meaning of an acronym should be spelled out at its first use in any claim. It is not

clear what Toso cell surface receptor means. Claims 10-15 and 26-29 are rejected insofar as they depend on rejected claim 9.

8b. Claim 9 is rejected as broad because in part (a) it is not clear if the addition of the bioactive agent takes place *in vitro* or *in vivo*. Claims 10-15 and 26-29 are rejected insofar as they depend on rejected claim 9.

8c. Claim 9 is rejected as vague and indefinite because in part (b) it is not clear if the apoptotic agent will bind Toso receptor to induce apoptosis. As written, there is no nexus between Toso and the apoptotic agent. Claims 10-15 and 26-29 are rejected insofar as they depend on rejected claim 9.

8d. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: The problem is it does not say where in the method of claim 9 this occurs, how it relates to the rest of the method.

8e. Claim 11 is rejected as indefinite because it is not clear when the labeling agent that will label apoptotic cells are added. Claims 12 and 13 are rejected insofar as they depend on rejected claim 11.

8f. Claim 12 is rejected as indefinite because it is not clear when the cells are separated between apoptotic cells and non-apoptotic cells.

8g. Claim 16 is rejected as indefinite because in the claim both Toso and the compound are each defined by the other. Claims 17 and 18 are rejected insofar as they depend on rejected claim 16.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nolan et al. PGPUB U.S 20020177565A1 discloses an identical protein to the instant invention. It also discusses apoptosis. However, the nucleotide sequence for this protein was not disclosed in the provisional application 60/066,063. Thus, the earliest priority date for Hitoshi et al. is 08/17/1998 that is after the filing of the instant invention (file date 03/30/1998).

10. No claims are allowable.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon whose telephone number is 703-305-1112. The examiner can normally be reached on M-F: 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 703-308-4623. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

JS



**LORRAINE SPECTOR  
PRIMARY EXAMINER**